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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,953	04/07/2005	Balthasar Miller	4358-13	8618
23117 7590 03/04/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
MERCADO, JULIAN A				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
03/04/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,953

Applicant(s)

MILLER, BALTHASAR

Examiner

JULIAN MERCADO

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-27 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed on November 2, 2009.

Claims 19-27 and 30-37 are pending for consideration.

Claim Objections

The prior objection of claims 24-27 has been obviated.

(new objection)

Claims 19-27 and 30-37 are objected to because of the following informalities:

The amendment to the claims now uses alternate spellings of the term "fibres" and "fibers". It is suggested to use either version consistently throughout the claims and specification and without the other.

Appropriate correction is required.

Drawings

The replacement drawings filed on November 2, 2009 are acceptable.

Claim Rejections - 35 USC § 112

The rejection of claims 20 and 21 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-27 and 30-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 19 and claim 22 has each been amended to recite the electrically conducting porous material as being comprised of carbonized/graphitized polymeric fibers without the addition of carbon particles. The limitation drawn to the porous material being *without the addition of carbon particles* is considered to be new matter. Applicant's specification has been reviewed but is found entirely silent on any feature which precludes any type of addition of carbon particles. Additionally, it is noted that applicant's remarks have not provided page and/or line citations to the specification or any other portion of the original disclosure in support of this feature.

Claims 20, 21, 23-27 and 30-37 are rejected under 35 U.S.C. 112, first paragraph as being dependent upon a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-27 and 30-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 and claim 22 has each been amended to recite the material as being comprised of carbonized/graphitized polymeric fibers without the addition of carbon particles. The limitation drawn to the porous material being *without the addition of carbon particles* is considered indefinite as it attempts to define the invention in terms of what it did not invent rather than distinctly and particularly pointing out what is actually invented. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

Claim 36 recites the limitation where "it does not comprise any filler" in lines 1-2. It is unclear if by "it" the claim intends to recite antecedence to the non-woven fabric, to the polymer fibers or to the carbonized/graphitized polymeric fibers.

Claims 20, 21, 23-27 and 30-37 are rejected under 35 U.S.C. 112, second paragraph as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mussell et al. (U.S. Pat. 5,620,807).

The rejection is maintained for the reasons already of record. Notwithstanding the 35 U.S.C. 112, first and second paragraph rejection of the claims (discussed above), the examiner notes the amendment to claim 19 now reciting the material being comprised of carbonized/graphitized polymeric fibers.... For the reasons of record, in Mussell et al. the material is asserted as being comprised of carbonized/graphitized polymeric fibers such as carbon/PTFE fibers of a specified ratio. See col. 6 line 9 et seq. and col. 7 line 36 et seq. As to this material being without the addition of carbon particles, giving the claims its broadest reasonable interpretation and notwithstanding the new matter rejection of the claimed "without the addition of carbon particles", it is asserted that Mussell et al. specifically discloses this feature insofar as the addition is either of carbon fibers *or* particles. (Ib., emphasis added)

Applicant's arguments filed with the present amendment have been fully considered, however they are not found persuasive. Applicant submits that Mussell et al. uses a known process which has certain drawbacks, in contrast to the claimed invention which employs a densification step and calendaring process which controls the porosity of the treated material. These arguments are not persuasive as such alleged differences in the process of making the material do not patentably distinguish the product claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(new rejection)

Claims 23 and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mussell et al. (U.S. Pat. 5,620,807) in view of DeCrescente et al. (U.S. Pat. 4,064,207).

The teachings of Mussell et al. are discussed above.

The examiner notes the amendment to the claim now reciting the cover layer consisting of fibrillated calendared and subsequently carbonized/graphitized polymeric fibers. While Mussell et al. does not explicitly teach this feature, the skilled artisan would find obvious to employ fibrillated and calendared fibers in order to control the physical and mechanical properties thereof, e.g. its porosity, bulk density and specific gravity. See DeCrescente et al. in col. 2 line 46 et seq. and col. 4 line 38 et seq.

Applicant's argument that no fibrillated fibers are used in Mussell et al. has been fully considered but is deemed moot in view of the new ground of rejection herein discussed as necessitated by the present amendment. Furthermore, the argument that Mussell et al. refers to powder is not persuasive for the reasons already discussed, to wit, Mussell et al. teaches either of carbon fibers *or* particles in the alternative.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1795

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

/Julian Mercado/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795